

REMARKS

Claims 1-37 have been examined on their merits.

Applicant herein cancels claims 5, 19, 20, 25, 26, 30, 31, 34 and 35 without prejudice and/or disclaimer.

Claims 1-4, 6-18, 21-24, 27-29, 32, 33, 36 and 37 are all the claims presently pending in the application.

1. Claims 13-16, 19, 20, 22, 25, 26 and 28 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Callahan *et al.* (U.S. Patent No. 6,396,473). The rejection of claims 19, 20, 25 and 26 is now moot due to their cancellation. Applicant traverses the rejection of claims 13-16, 22 and 28 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). A proper anticipation rejection requires that every element of the claim be found “in a single prior art reference.” *See In re Robertston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). For anticipation to exist, there must be no

difference between the claimed invention and the reference disclosure, as that reference would be understood by one of ordinary skill in the art. *See Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir 1991); *see also, Crown Operations Intn'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Further, “an anticipating reference must describe the [claimed] subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1998) (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Callahan *et al.* fail to teach or suggest at least merging a base image having a base image element and a secondary image having a secondary image element, wherein if the base image element and the secondary image element correspond to each other, they are both blanked out from the final page window, as recited in claim 13. There is no teaching or suggestion in Callahan *et al.* of base and secondary elements corresponding to one another, and there is clearly no teaching or suggestion of blanking base and secondary image elements if the elements correspond to each other. *See, e.g.*, Figures 2A, 2D and 3B of the instant application. At best, Callahan *et al.* disclose overlaying a portion of one image onto another image, and Callahan *et al.* certainly do not teach or suggest a base image that is completely overlaid by a secondary

image, as recited in claim 13. *See, e.g.*, Figures 1 and 3 of Callahan *et al.* Even the partial overlaying of images in Callahan *et al.* does not teach the correspondence of a base image element to a secondary image element, as recited in claim 13. In sum, the page window recited in claim 13 is completely different than video/graphic display of Callahan *et al.*

Based on the foregoing reasons, Applicant submits that Callahan *et al.* fail to teach or suggest all of the claimed elements as arranged in claim 13. Therefore, under *Hybritech* and *Richardson*, Callahan *et al.* clearly cannot anticipate the present invention as recited in independent claim 13. Thus, Applicant submits that claim 13 is allowable, and further submits that claims 14-16 are allowable as well, at least by virtue of their dependency from claim 13. Applicant respectfully requests that the Patent Office withdraw the § 102(e) rejection of claims 13-16.

With respect to independent claim 22, Applicant submits that claims 22 and 28 are allowable at least for reasons analogous to those discussed above with respect to claim 13. Therefore, under *Hybritech* and *Richardson*, Applicant submits that claims 22 and 28 are allowable, and respectfully requests that the Patent Office withdraw the § 102(e) rejection of claims 22 and 28.

2. Claims 1-12, 17, 18, 21, 23, 24, 27 and 29-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miyagaki *et al.* (U.S. Patent No. 4,942,515) in view of Callahan *et al.* The rejection of claims 5, 30, 31, 34 and 35 is now moot due to their cancellation. Applicant traverses the rejection of claims 1-4, 6-12, 17, 18, 21, 23, 24, 27-29, 32, 33, 36 and 37 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d 1016, 1022-23 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior

art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.*

Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

The combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest at least merging a base image having a base image element and a secondary image having a secondary image element, wherein if the base image element and the secondary image element correspond to each other, they are both blanked out from the final page window, as recited in claim 1. There is no teaching or suggestion in the combination of Miyagaki *et al.* and Callahan *et al.* of base and secondary elements corresponding to one another, and there is clearly no teaching or suggestion of blanking base and secondary image elements if the elements correspond to each other. *See, e.g.*, Figures 2A, 2D and 3B of the instant application. At best, the combination of Miyagaki *et al.* and Callahan *et al.* discloses overlaying a portion of one image onto another image, and the combination of Miyagaki *et al.* and Callahan *et al.* certainly does not teach or suggest a base image that is completely overlaid by a secondary image, as recited in claim 1. *See, e.g.*, Figures 1 and 3 of Callahan *et al.* Even the partial overlaying of images in the combination of Miyagaki *et al.* and Callahan *et al.* does not teach the correspondence of a base image element to a

secondary image element and the blanking thereof, as recited in claim 13. In sum, the page window recited in claim 1 is completely different than video/graphic display of the combination of Miyagaki *et al.* and Callahan *et al.*

Applicant submits that one of skill in the art would not have been motivated to combine the two references. Both Miyagaki *et al.* and Callahan *et al.* lack any teaching about the desirability of multiple overlaid images to create a page window for a computer system, wherein image elements that correspond to each other are blanked out in the merged page window. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness with respect to claim 1, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other. Therefore, the combination of Miyagaki *et al.* and Callahan *et al.* clearly cannot render the present invention obvious as recited in claim 1. Applicant submits that claim 1 is allowable, and further submits that claims 2 and 3 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 1-3.

With respect to independent claim 4, Applicant submits that claim 4 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination

of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other. Applicant submits that claim 4 is allowable, and further submits that claim 6 is allowable as well, at least by virtue of its dependency from claim 4. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 4 and 6.

With respect to independent claim 7, Applicant submits that claim 7 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other. Applicant submits that claim 4 is allowable, and further submits that claims 8-12 are allowable as well, at least by virtue of their dependency from claim 7. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 7-12.

With respect to dependent claims 14, 17, 18 and 21, Applicant submits that claims 14, 17, 18 and 21 are allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other (as recited in independent claim 13 and included via dependency in claims 14, 17, 18 and 21).

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Applicant submits that claims 14, 17, 18 and 21 are allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 14, 17, 18 and 21.

With respect to dependent claims 23, 24 and 27, Applicant submits that claims 23, 24 and 27 are allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other (as recited in independent claim 22 and included via dependency in claims 23, 24 and 27). Applicant submits that claims 23, 24 and 27 are allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 23, 24 and 27.

With respect to independent claim 29, Applicant submits that claim 29 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other. Applicant submits that claim 29 is allowable, and further submits that claim 32 is allowable as well, at least by virtue of its dependency from claim 29. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 29 and 32.

With respect to independent claim 33, Applicant submits that claim 33 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image

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and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other. Applicant submits that claim 33 is allowable, and further submits that claim 36 is allowable as well, at least by virtue of its dependency from claim 33. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 33 and 36.

With respect to independent claim 37, Applicant submits that claim 37 is allowable at least for reasons analogous to those discussed above with respect to claim 1, in that the combination of Miyagaki *et al.* and Callahan *et al.* fails to teach or suggest merging a base image and a secondary image to create a page window, wherein base image elements and secondary image elements are blanked out if they correspond to each other. Applicant submits that claim 37 is allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claim 37.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue, which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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